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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 09/764,365 | 01/18/2001 | Donald E. Weder | 8403.186 | 9606 |
| 30589 | 7590 | 05/28/2004 | | |
| DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY, OK 73113 | | | EXAMINER STEIN, STEPHEN J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1775 | |

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,365

Applicant(s)

WEDER, DONALD E.

Examiner

Stephen J Stein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date, _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Reissue Application

1. Section 251 of title 35, United States Code, first paragraph, provides that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

2. Claims 1 through 12 are rejected under 35 U.S.C. § 251 on the basis that the changes being sought by reissue would not correct a patent “deemed wholly or partly inoperative or invalid” within the meaning of 35 U.S.C. § 251. The Director is authorized to reissue a patent only when a “patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent.” See 35 U.S.C. § 251, ¶ 1.

The reissue declaration states only that: The patent is partly inoperative or invalid as it incorporates and references back further [*sic.*, farther] than is required.

Sections 154(a)(2) and (a)(3) of title 35, United States Code, provide that:

(2) TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years

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from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

(3) PRIORITY.—Priority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent.

The above-identified application is a reissue application of U.S. Patent No. 5,861,199 (issued on January 19, 1999), which patent resulted from application No. 08/717,469, filed on September 20, 1996. As filed on September 20, 1996, the specification of application No. 08/717,469 begins with the following sentence¹--

This application is a continuation-in-part of copending application U.S. Serial No. 08/454,474, filed May 30, 1995, entitled "OPTICAL EFFECT MATERIAL AND METHODS"; which is a continuation of U.S. Serial No. 08/179,057, filed January 7, 1994, entitled "OPTICAL EFFECT MATERIAL AND METHODS"; which is a continuation-in-part of U.S. Serial No. 07/968,798, filed October 30, 1992, entitled "METHOD AND APPARATUS FOR COVERING PORTIONS OF AN OBJECT WITH A SHEET OF MATERIAL HAVING A PRESSURE SENSITIVE ADHESIVE COATING APPLIED TO AT LEAST A PORTION OF AT LEAST ONE SURFACE OF THE SHEET OF MATERIAL", now U.S. Patent No. 5,369,934; which is a continuation of U.S. Serial No. 07/865,563, filed April 9, 1992, entitled "METHODS FOR WRAPPING A FLORAL GROUPING", now U.S. Patent No. 5,245,814; which is a continuation of U.S. Serial No. 07/649,379, filed January 31, 1991, entitled "METHOD FOR WRAPPING AN OBJECT WITH A MATERIAL HAVING PRESSURE SENSITIVE ADHESIVE THEREON", now U.S. Patent No. 5,111,638; which is a continuation of U.S. Serial No. 249,761, filed September 26, 1988, entitled "METHOD FOR WRAPPING AN OBJECT WITH A MATERIAL HAVING PRESSURE SENSITIVE ADHESIVE THEREON", now abandoned; which is a continuation-in-part of U.S. Serial No. 219,083, filed July 13, 1988, entitled "ARTICLE FORMING SYSTEM", now U.S. Patent No. 4,897,031; which is a continuation of Serial No. 004,275, filed January 5, 1987, entitled "ARTICLE

¹ The specification of application No. 08/717,469 also contains additional specific references under 35 U.S.C. § 120. Application No. 06/613,080, filed May 22, 1984, is the earliest filed application to which there is a specific reference under 35 U.S.C. § 120.

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FORMING SYSTEM", now U.S. Patent No. 4,773,182; which is a continuation of 613,080, filed May 22, 1984, entitled "ARTICLE FORMING SYSTEM", now abandoned.

This first sentence of the specification of application No. 08/717,469 contains a specific reference under 35 U.S.C. § 120² to (*inter alia*) application No. 06/613,080, filed May 22, 1984. Cf. Abbott Lab. v. Novopharm Ltd., 104 F.3d 1305, 1309, 41 USPQ2d 1535, 1537 (Fed. Cir. 1997) (the statement that an application is a divisional application of a prior-filed application is a specific reference to the prior-filed application in accordance with 35 U.S.C. § 120 for purposes of 35 U.S.C. § 154(a)(2), regardless of whether the divisional application actually received any benefit from the prior-filed application). Therefore, the expiration of the term of U.S. Patent No. 5,861,199 is measured from the filing date of application No. 06/613,080, namely May 22, 1984. See *id.*, 41 USPQ2d at 1537; see also Changes to Implement 20-Year Patent Term and Provisional Applications, 60 Fed. Reg. 20195, 20205 (Apr. 25, 1995) (response to comment 5³). Accordingly, the term of U.S. Patent No. 5,861,199 expires on May 22, 2004.

As indicated by the U.S. Court of Appeals for the Federal Circuit: "[t]he language of [35 U.S.C. §] 251 is unambiguous: the [Director] has authority to reissue a patent only 'for the

² In addition, the declaration filed in application No. 08/717,469 on September 20, 1996 also states that applicant claims the benefit under 35 U.S.C. § 120 of (*inter alia*) application No. 06/613,080, filed May 22, 1984.

³ The response to comment 5 states:

Under 35 U.S.C. § 154(a)(2), if an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. § 120, 121 or 365(a), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. § 120, 121 or 365(a). For a CIP application, applicant should review whether any claim in the patent that will issue is supported in an earlier application. If not, applicant should consider canceling the reference to the earlier filed application.

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unexpired term of the original patent.” See In re Morgan, 990 F.2d 1230, 1231, 26 USPQ2d 1392, 1393 (Fed. Cir. 1993) (quoting 35 U.S.C. § 251, ¶ 1). Therefore, assuming (*arguendo*) that the conditions of 35 U.S.C. § 251 were otherwise satisfied, the Director has the authority to reissue U.S. Patent No. 5,861,199 only for a term that will expire on May 22, 2004. See 35 U.S.C. § 251, ¶ 1 (“the Director shall . . . reissue the patent . . . for the unexpired part of the term of the original patent”); see also Questions and Answers Regarding the GATT Uruguay Round and NAFTA Changes to U.S. Patent Law and Practice at 8 (June 1995) (answer to question 4⁴). Put simply, even if the Office were to reissue U.S. Patent No. 5,861,199 with a disclaimer of any or all of the benefit claims under 35 U.S.C. § 120 in U.S. Patent No. 5,861,199, such a reissue patent would expire on May 22, 2004 by operation of law (35 U.S.C. 251, ¶ 1) because a reissue patent is limited to “the unexpired part of the term of the original patent.” See 35 U.S.C. § 251, ¶ 1.

The Office is authorized to grant a reissue patent only to correct a patent “deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent.” See 35 U.S.C. § 251, ¶ 1. 35 U.S.C. § 251 is not a panacea for all patent prosecution problems, and is not a second opportunity to prosecute the original application *de novo*. See In re Weiler, 790 F.2d 1576, 1582, 229 USPQ 673, 677 (Fed. Cir. 1986). Such is the case here; *i.e.*, removal of a benefit claim is **not** an error that is correctable by reissue.

⁴ Question: Can a patentee disclaim/claim the benefit of the filing date of an earlier filed application after the patent issues?

Answer: Yes, so long as the conditions of 35 U.S.C. § 251 are satisfied. Note that a disclaimer will not, however, operate to extend the term of a patent as the term of a reissued patent is limited by the unexpired term of the original patent.

Applicant states that U.S. Patent No. 5,861,199 is partly inoperative or invalid as it incorporates and references back further [*sic.*, farther] than is required (presumably for the purpose of attempting to change the patent's term). The reissuance of U.S. Patent No. 5,861,199 to disclaim certain prior-filed applications by eliminating the specific references under 35 U.S.C. § 120 to such prior-filed applications would not correct any inoperativeness in U.S. Patent No. 5,861,199 because (as discussed above) any such reissue patent is limited to "the unexpired part of the term of the original patent" and thus would also expire on the expiration date of U.S. Patent No. 5,861,199 (May 22, 2004). The reissuance of U.S. Patent No. 5,861,199 to disclaim certain prior-filed applications by eliminating the specific references under 35 U.S.C. § 120 to such prior-filed applications would not correct any invalidity in U.S. Patent No. 5,861,199 because the disclaimer of a prior-filed application, unlike the addition of a claim to priority to or the benefit of a prior-filed application, is never necessary for the validity of a patent. Therefore, 35 U.S.C. § 251 does not authorize the Office to reissue U.S. Patent No. 5,861,199 for the sole purpose of disclaiming prior-filed applications by eliminating the specific references under 35 U.S.C. § 120 to such prior-filed applications from U.S. Patent No. 5,861,199. See In re Bose, 687 F.2d 432, 432, 215 USPQ 1, 2 (CCPA 1982) (a reissue that does not seek a substantive change to the original patent is nothing more than a request for an advisory opinion).

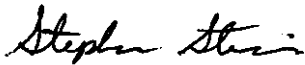
Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Stein whose telephone number is 572-272-1544. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m. If the attempts to reach the examiner are unsuccessful, the examiner's supervisor, Deborah Jones can be reached by dialing 571-272-1535. The official fax number is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 20, 2004



Stephen J. Stein
Primary Examiner
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